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In re Application of :
Yuqiao Shen :
Serial No.: 10/669,768 : PETITION DECISION
Filed: September 24, 2003 :
Attorney Docket No.: ONYX1047-DIV :

This is in response to the petition under 37 CFR 1.181, filed July 09, 2007, requesting to review the proceedings in an ex parte action or requirement in a patent application by the Examiner, specifically regarding the Examiner's action of rejection of previously allowed claims.

BACKGROUND

On March 02, 2006, the examiner mailed an office action, restricting the claims in Groups I, claims 9 and 10; Group II claims 9 and 10; Group III, claims 6 and 7; Group IV, claims 6 and 8; Group V, claims 11, 12, 14-16, 18 and 19 and Group IV, claims 11, 13, 14, 15 and 17-19.

On April 5, 2006, applicant filed a response, canceling claims 6-10, amending claims 11-19 and electing Group V, with traverse for examination purpose.

On June 19, 2007, the examiner mailed a non-final Office action, objecting claims 11 and 14, rejecting claims 14-19, 23 and 29-32 under 35 U.S.C. 112 first paragraph, as failing to comply with the written restriction requirement, rejecting claims 11, 13-19 and 23-32 under 35 U.S.C. 112 first paragraph, for lack of enablement within the scope of the claimed invention and objecting to claim 12 as being dependent upon a rejected base claim.

On September 21, 2006, applicant filed a response, arguing the rejections and amending the claims and the specification.

On December 14, 2006, the examiner mailed a final Office action, rejecting claims 14, 16, 17, 29-32 and the newly added claims 41-47 under 35 U.S.C. 112 first paragraph, as failing to comply with the written description requirement, rejecting claims 14, 16, 17, 29-32, 33 and 35-

47 under 35 U.S.C. 112 first paragraph, for lack of enablement within the scope of the claimed invention and indicating claims 11-13, 24-28 and 34 as allowable.

On April 26, 2007, applicant filed a response, arguing the rejection, canceling the rejected claims and remaining claims 11-13, 24-28 and 34 as indicated allowable by the examiner.

On May 9, 2007 the examiner mailed a non-final Office action, rejecting claims 11, 12, 24, 28, 33, 39 and 40 under 35 U.S.C. 112 first paragraph, for lack of enablement within the scope of the claimed invention and objecting to claims 13, 25-27 and 35-38 as being dependent upon a rejected base claim. The examiner indicated that the objected claims would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

In response thereto, applicant filed this petition on July 9, 2007, requesting the withdrawal of the "new", non-final rejection of May 9, 2007 and issuance of a Notice of allowability for the pending claims, i.e., claims 11-13, 24-28, 33, and 35-40.

DISCUSSION

Applicant in his remarks argues, that in order to reject the claims, which were indicated as allowable in the previous Office action, according to MPEP 706.04 the careful review and consideration of a primary examiner is required. Applicant also argues that the new rejection of May 9, 2007 asserted by the examiner is not new and was overcome previously. Applicant's attention is drawn to page 2, lines 1-4 of the office action of May 9, 2007, indicating that upon review of the claims of the instant application in a **patentability conference** it is apparent that the application is not in condition for allowance. Such statement indicates, that the examiner's position on the allowability of the claims was reversed in a patentability conference held with two supervisors or a supervisor and a primary examiner. Moreover, the final page of the Office action includes the signature of Supervisory Patent Examiner Joe Woitach, who also has authorization to sign as a Primary examiner. Thus, in the instant case the requirement of MPEP 706.04 was met by the Office, and the case was reopened for examination. This is also consistent with MPEP 1005, which permits a Primary Patent examiner to reject previously allowed claims.

Some of applicants' arguments in the petition appear to be directed to appealable matters based on the merits of the rejection. Filing a petition is not a substitution for complete reply to an outstanding Office action. Alternatively, because the claims of the instant application have been twice rejected by a primary examiner, applicant may appeal the rejections of record to the Board of Patent Appeals and Interferences. Applicant's attention is directed to MPEP 37 CFR 41.31.

****>37 CFR 41.31. Appeal to Board.**

(a) *Who may appeal and how to file an appeal.* (1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirement of § 1.33 of this title does not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.<

DECISION

Accordingly, the petition is **DENIED**.

Any request for consideration must be filed within two (2) months of the mailing date of this decision.

Applicants remain under obligation to reply to the Final Office action mailed 9 May 2007 with in the response time specified therein or as extendable under 37 CFR 1.136(a).

Should there be any questions about this decision please contact Special Program Examiner Julie Burke, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Christopher Low
Director, Technology Center 1600 (Acting)